

REMARKS

Claims 2 and 4-19 are pending in this application. Claims 1 and 5 stand rejected and claim 3 is objected to. Applicants wish to thank the Examiner for the indication of allowable subject matter in claim 3. By this Amendment, claims 1 and 3 have been cancelled in lieu of new claims 16 and 17. Claim 5 has been amended depended from new claim 16. Claims 16-19 have been added. No new matter has been added. The amendments made to the claims do not alter the scope of these claims, nor have these amendments been made to define over the prior art. Rather, the amendments to the claims have been made for cosmetic reasons to improve the form thereof. In light of the amendments and remarks set forth below, Applicants respectfully submit that each of the pending claims is in immediate condition for allowance.

Claims 1 and 5 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,567,244 ("Gill") in view of U.S. Patent No. 6,583,967 ("Kasahara"). Applicants request reconsideration and withdrawal of this rejection.

To establish a *prima facie* case of obviousness, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify a reference or combine references to arrive at the claimed subject matter. The prior art references must also teach or suggest all the limitations of the claim in question. See, M.P.E.P. § 706.02(j). A reference can only be used for what it clearly discloses or suggests. See, In re Hummer, 113 U.S.P.Q. 66 (C.C.P.A. 1957); In re Stencel, 4 U.S.P.Q.2d

1071, 1073 (Fed. Cir. 1987). Here, the references, whether taken individually or in combination, do not disclose or suggest the invention claimed by the Applicant.

The Office Action asserts that Gill discloses a pair of magnetic tunnel junction structures shown in Figure 11 and discussed at column 5, lines 30-32. The Office Action goes on to admit that Gill does not disclose the structure relationship of a barrier film, lower and upper magnetic layer, a conductive layer, a substrate and upper electrode layer as recited in claim 1. To cure this deficiency, the Examiner includes the Kasahara reference. The Kasahara reference was filed on June 14, 2001. The present application was filed February 6, 2001. As such, the Kasahara reference is not prior art. Accordingly, claims 1 and 5 are allowable over Gill.

Claims 2, 4, 5, and 17-19 depend from, and contain all the limitations of claim 16. These dependent claims also recite additional limitations which, in combination with the limitations of claim 16, are neither disclosed nor suggested by Gill and are also directed towards patentable subject matter. Thus, claims 2, 4, 5, and 17-19 should also be allowed.

Applicants have responded to all of the rejections and objections recited in the Office Action. Reconsideration and a Notice of Allowance for all of the pending claims are therefore respectfully requested.

In view of the above, each of the presently pending claims in this application is believed to be in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to withdraw the outstanding rejection of the claims and to pass this application to issue.

Application No.: 09/777,325

Docket No.: X2007.0079/P079

If the Examiner believes an interview would be of assistance, the Examiner is welcome to contact the undersigned at the number listed below.

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Respectfully submitted,

By 

Ian R. Blum

Registration No.: 42,336

DICKSTEIN SHAPIRO MORIN &
OSHINSKY LLP

1177 Avenue of the Americas - 41st Floor
New York, New York 10036-2714
(212) 835-1400

Attorney for Applicants

IRB/mgs